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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/674,643	09/30/2003	Stephen H. Roby	T-6172 (538-52)	4801

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EXAMINER

ANTHONY, JOSEPH DAVID

ART UNIT PAPER NUMBER

1714

DATE MAILED: 11/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/674,643

Applicant(s)

ROBY ET AL.

Examiner

Joseph D. Anthony

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

FINAL REJECTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-11, 15, 18-22, and 26-31 are rejected under 35 U.S.C. 102(b) as being anticipated by Kodali et al. U.S. Patent Number 6,278,006.

Kodali et al. teach oils containing transesterified reaction products of triacylglycerol polyol ester, such as IMC-130 oil with a non-glycerol polyol ester, such as TMPTH, as well as methods of making such. Methods for improving lubrication properties of a vegetable oil also are described see abstract, see abstract and column 5, line 20 to column 7, line 18. Please note that unreacted triacylglycerol polyol esters, such as IMC-130 oil, are deemed to read on applicant's claimed "base oil of lubricating viscosity" (i.e. component (a)), wherein the transesterified reaction product of triacylglycerol polyol ester with a non-glycerol polyol ester are deemed to read on applicant's component (b). Applicant's claims are deemed to be anticipated over the Example 4 wherein a model is constructed for the transesterification of IMC-130 oil and TMPTH as shown in FIG. 3. A review of FIG. 3 clearly shows that at lower concentrations of TMPTH reactant (lower than about 15 wt.%), the concentration of the transesterified reaction product of IMC-130 oil and TMPTH is in a minor amount compared to the concentration of the unreacted IMC-130 oil which would be in a major amount.

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4. Claims 12 and 23 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kodali et al. U.S. Patent Number 6,278,006.

Kodali et al. has been described above and is deemed to anticipated applicant's claimed invention for the reasons set forth above. In the alternative, Kodali et al. may differ from applicant's claimed invention in that it is unclear if there is a direct teaching (i.e. by way of a specific example) to a lubricating oil composition that actually comprises applicant's component (b) within applicant's particular claimed concentration ranges. It would have been obvious to one having ordinary skill in the art to make a lubrication oil composition that actually comprises applicant's component (b) within applicant's particular claimed concentration range since such directly falls within the disclosure of Kodali et al.'s Example 4 wherein a model is constructed for the transesterification of IMC-130 oil and TMPTH as shown in FIG. 3. A review of FIG. 3 clearly shows that at lower concentrations of TMPTH reactant (lower than about 15 wt.%), the concentration of the transesterified reaction product of IMC-130 Oil and TMPTH is in a minor amount compared to the concentration of the unreacted IMC-130 oil which would be in a major amount.

5. Claims 1-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lal U.S. Patent Number 5,338,471 in view Kodali et al. U.S. Patent Number 6,278,006.

Lal teaches This invention relates to a composition containing the combination of: (A) at least one vegetable or synthetic triglyceride, (B) esters from the transesterification

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of at least one animal or vegetable oil triglyceride, (C) a pour point depressant, and (D) a performance additive. The composition may optionally contain (E) other oils (such as mineral oils), see abstract. Lai differs from applicant's lubricating oil composition in that Lai component "(B) esters from the transesterification of at least one animal or vegetable oil triglyceride" appear to be different from applicant's claimed component (b) because Lai transesterfying process is different from applicant's transesterfying process.

Kodali et al. has all been described above.

It would have been obvious to one having ordinary skill in the art to use the direct teaching of the secondary reference to Kodali et al. as strong motivation to actually use their transesterfied product in lieu of or in addition to the transesterfied products directly disclosed by Lai for the benefits that these oxidative stable transesterfied products are taught to have. To use the transesterfied products, as taught by the Kodali et al. secondary reference, within all of applicant's claimed concentration ranges, is also deemed to be obvious since the secondary reference to Kodali et al. directly discloses these concentration ranges, including those of dependent claims 13-14 and 24-25 (when very low concentrations of TMPH reactant are used in the transesterifying reaction), see Example 4 wherein a model is constructed for the transesterification of IMC-130 oil and TMPH as shown in FIG. 3.

Response to Arguments

6. Applicant's arguments filed 10/16/06 with the amendment have been fully considered but are not persuasive to put the application in condition for allowance for the reasons set forth above. Additional examiner comments are set forth next. The previously made prior-art rejections that have now been dropped have been dropped in light of applicant's amendment, 1.131 Declaration and arguments as set forth in said amendment. Likewise, applicant's arguments against the previously made provisional ODP rejections have been accepted by the examiner, and as such they have been dropped. In applicant's remarks concerning the applied Kodali et al patent, applicant specifically inquired where there is a disclosure to making compositions comprising a minor amount of a transesterified reaction product according to applicant's component (b) in conjunction with a major amount of a base oil of lubricating viscosity (i.e. component (a)). The above prior-art rejections are deemed to clearly answer applicant's inquiry.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

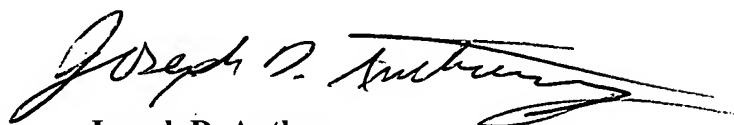
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Examiner Information

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Joseph D. Anthony whose telephone number is (571) 272-1117. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on (571) 272-1119. The centralized FAX machine number is (571) 273-8300. All other papers received by FAX will be treated as Official communications and cannot be immediately handled by the Examiner.



Joseph D. Anthony
Primary Patent Examiner
Art Unit 1714

11/26/06